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To Examiner A. Chevalier
Fax no. 571-273-8300 Phone no.
From Kristin S. Schrimper Phone no. 703.610.8683
Date August 4, 2006 Time
Application No: 10/779,771;
File no. Our Ref.: A-10035 Pages including cover 3

Message

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A-10035
PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

First Named Inventor: SCHATY, HARALD Art Unit: 1772

Appln. No.: 10/779,771 Examiner: A.
Chevalier

Filed: February 18, 2004 Conf. No.: 1637

For: DISK-SHAPED OBJECT OF SYNTHETIC
THERMOPLASTIC MATERIAL AND METHOD FOR
PRODUCING SAME

* * *

REQUEST FOR WITHDRAWAL OF THE FINALITY OF THE OFFICE ACTION
MAILED JULY 5, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests that the finality of the Office Action mailed July 5, 2006 be withdrawn and that the Office Action be designated as non-final.

Paragraph 8 on page 4 of the Office Action alleges that "Applicant's Amendment necessitated the new ground(s) of rejection presented in this Office Action." Respectfully, this assertion is clearly without foundation.

In the Amendment dated April 12, 2006, claim 1 was amended to delete the phrase "such as thermoplastic

adhesive" to overcome the rejection under 35 U.S.C. § 112. No claim amendments were made to overcome the rejection under 35 U.S.C. 102(b) based on Kubota. Applicant argued the inappropriateness of this rejection, and the rejection was withdrawn in the present Office Action.

It is not apparent how the deletion of "such as thermoplastic adhesive" from claim 1 necessitated the new grounds of rejection in the present Office Action. Moreover, fairness requires that Applicant have the opportunity to respond to the new ground of rejection without the restrictions of the final rejection practice.

The Commissioner is hereby authorized to charge to Deposit Account No. 50-1165 (A-10035) any fees under 37 C.F.R. §§ 1.16 and 1.17 that may be required by this paper and to credit any overpayment to that Account. If any extension of time is required in connection with the filing of this paper and has not been separately requested, such extension is hereby requested.

Respectfully submitted,

By: Nelson H. Shapiro
Nelson H. Shapiro
Reg. No. 17,095

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August 4, 2006

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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on the date shown below.

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8/4/06

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